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| 09/818,157 | 03/27/2001 | Jose Luis Montero | 60001.0043US01 | 1935 |

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EXAMINER

CAMPBELL, JOSHUA D

| | |
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| ART UNIT | PAPER NUMBER |
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2179

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,157

Applicant(s)

MONTERO ET AL.

Examiner

Joshua D Campbell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/16/2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 16-24, 26, 28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 16-24, 26, 28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/25/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Request for continued examination filed on 12/16/2004 and IDS filed on 01/25/2005.
2. Claims 1-4, 6-13, 16-24, 26, 28, and 30-34 are pending in this case. Claims 1, 13, 24, 31 and 34 are independent claims. Claims 5, 14, 15, 25, 27, and 29 have been cancelled. Claims 1, 6, 7-9, 11-13, 16-21, 24, 26, 28, and 30 have been amended. Claims 31-34 have been newly added.
3. The rejection of claims 13 and 17-19 under 35 U.S.C. 112, second paragraph, as being indefinite has been withdrawn due to amendments.
4. The rejection of claims 1-11, 13-22, 24, 26, and 28 under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (hereinafter Miller, US Patent Number 5,896,321) in view of Malik (US Patent Application Publication Number 2002/0065891) has been withdrawn due to amendments.
5. The rejection of claims 12, 23, and 30 under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (hereinafter Miller, US Patent Number 5,896,321) in view of Malik (US Patent Application Publication Number 2002/0065891) as applied to claims 9, 13, and 24 above, and further in view of Beauregard et al. (IDS - hereinafter Beauregard, US Patent Number, 5,974,413) has been withdrawn due to amendments.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 4, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik (US Patent Application Publication Number 2002/0065891).

Regarding independent claim 1, Malik discloses a method in which an indication that a word has been entered in a first field is received by an email application, which is then broadcast to a checker application if the first word is a new word (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). Malik also discloses that a second word entered into a field may be indicated at which point the word is compared to a word list, and whether or not that word matches a word in the word list may indicate whether or not the word is spelled correctly (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Regarding dependent claim 2, Malik discloses a method that is stored on a computer readable medium to be executed by a computer (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Regarding dependent claim 4, Malik discloses that the word is an email name (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Regarding independent claim 34, Malik discloses a method in which an indication that a word has been entered in a first field is received by an email application, which is then broadcast to a checker application if the first word is

determined to be a new word (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). Malik also discloses that a second word entered into a field may be indicated at which point the word is compared to a word list, and whether or not that word matches a word in the word list may indicate whether or not the word is spelled correctly (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 3, 6-11, 13, 16-19, 22, 24, 26, 28, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US Patent Application Publication Number 2002/0065891).

Regarding dependent claim 3, Malik discloses a method in which if an email name is determined to be new it is stored in the word list (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). At which point the email address and display name, which could be a proper name (i.e. Montero), could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding dependent claim 6, Malik discloses a method in which the email name is compared to an email name list, and a matching name in the email name list

may be found that shares at least one characteristic with the email name (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). At which point the email address and display name could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding dependent claim 7, Malik discloses a method in which an email address is determined (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). At which point the email address and display name could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding dependent claim 8, Malik discloses a method in which it is determined that an email name has been entered into the TO field of an email note (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Regarding dependent claim 9, Malik discloses a method in which if an email name is determined to be new it is stored in the word list (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). At which point the email address and display name could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been

obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding dependent claim 10, Malik discloses a method in which the word list is an email dictionary (dictionary being defined as a listing words or other linguistic items in a particular category or subject with specialized information about them) (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Regarding dependent claim 11, Malik discloses a method in which the word list which a new word is added to is an email dictionary (dictionary being defined as a listing words or other linguistic items in a particular category or subject with specialized information about them) (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). Malik does not disclose a method in which it is stored in an auto-completion database. The applicant's disclosed (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that display names could be stored in an address book for an email application for auto-completion purposes (i.e. auto-completion database).

Regarding independent claim 13, Malik discloses a method in which an indication that a word has been entered in a first field is received by an email application, which is then broadcast to a checker application if the first word is a new word (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). Malik discloses a method in which the word list is an email dictionary (dictionary being defined as a listing words or other linguistic items in a particular category or subject with specialized

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information about them) (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

At which point the email address and display name could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding dependent claim 16, Malik discloses a method in which if an email name is determined to be new it is stored in the word list (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). At which point the email address and display name could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding dependent claims 17-19, Malik also discloses that a second word entered into a field may be indicated at which point the word is compared to a word list, and whether or not that word matches a word in the word list may indicate whether or not the word is spelled correctly (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Regarding dependent claim 22, Malik does not disclose a method in which it is stored in an auto-completion database. The applicant's disclosed (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of

ordinary skill in the art at the time the invention was made that display names could be stored in an address book for an email application for auto-completion purposes (i.e. auto-completion database).

Regarding independent claim 24, Malik discloses a method in which an indication that a email name has been entered in a first field is received by an email application, which is then broadcast to a spell-checker application if the email name is resolved to be new (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). At which point the email address and display name could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding independent claim 26, Malik discloses a method in which previously used email addresses (email cache) are retrieved and added to a custom email checker database (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik).

Regarding dependent claim 28, Malik discloses a method in which previously used email addresses (email cache) are retrieved and added to a custom email checker database (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). Malik does not disclose a method in which it is stored in an auto-completion database. The applicant's disclosed (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that

display names could be stored in an address book for an email application for auto-completion purposes (i.e. auto-completion database).

Regarding independent claim 31, Malik discloses a method in which an indication that a word has been entered in a first field is received by an email application, which is then broadcast to a checker application if the first word is a new word (Pages 4-5, paragraphs 0039-0045 and 0048-0051 of Malik). At which point the email address and display name could be resolved from the email name because as shown by the applicant's disclosure (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that upon entry of data into a TO field an email editor will resolve the elements necessary to properly compose the email.

Regarding dependent claim 32, Malik does not disclose a method in which it is stored in an auto-completion database. The applicant's disclosed (Background of Invention, pages 1-2) it was well known and thus would have been obvious to one of ordinary skill in the art at the time the invention was made that display names could be stored in an address book for an email application for auto-completion purposes (i.e. auto-completion database).

10. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US Patent Application Publication Number 2002/0065891) in view of Miller et al. (hereinafter Miller, US Patent Number 5,896,321).

Regarding dependent claims 20 and 21, Malik does not disclose a spell-checker in which the entered word is entered into the body of an email or a word processor document. However, Miller discloses a method in which an auto-completion module/spell checker can be used on word processing documents, body of emails, and TO fields in emails (column 5, lines 15-51 and column 7, lines 7-25 of Miller). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for more efficient data entry by the user.

11. Claims 12, 23, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US Patent Application Publication Number 2002/0065891) in view of Beauregard et al. (IDS - hereinafter Beauregard, US Patent Number, 5,974,413).

Regarding dependent claim 12, Malik discloses a method in which the list consist of email addresses and as shown by the applicants disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. Malik does not disclose that the new words are added to a smart-tags database. However, Beauregard discloses a method in which words can be stored in a semantic database (smart tag), which allows every word to be tied to an action (column 4, line 34-column 6, line 20 of Beauregard). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to have used the methods of Miller and Malik with the method of Beauregard because it would have increased the functionality of words in the system.

Regarding dependent claim 23, Malik discloses a method in which the list consist of email addresses and as shown by the applicants disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. Malik does not disclose that the new words are added to a smart-tags database. However, Beauregard discloses a method in which words can be stored in a semantic database (smart tag), which allows every word to be tied to an action (column 4, line 34-column 6, line 20 of Beauregard). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods of Miller and Malik with the method of Beauregard because it would have increased the functionality of words in the system.

Regarding dependent claim 30, Malik discloses a method in which the list consist of email addresses and as shown by the applicants disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. Malik does not disclose that the new words are added to a smart-tags database. However, Beauregard discloses a method in which words can be stored in a semantic database (smart tag), which allows every word to be tied to an action (column 4, line 34-column 6, line 20 of Beauregard). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods of Miller and Malik with the method of Beauregard because it would have increased the functionality of words in the system.

Regarding dependent claim 33, Malik discloses a method in which the list consist of email addresses and as shown by the applicants disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. Malik does not disclose that the new words are added to a smart-tags database. However, Beauregard discloses a method in which words can be stored in a semantic database (smart tag), which allows every word to be tied to an action (column 4, line 34-column 6, line 20 of Beauregard). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods of Miller and Malik with the method of Beauregard because it would have increased the functionality of words in the system.

Response to Arguments

12. Applicant's arguments with respect to claims 1-4, 6-13, 16-24, 26, 28, and 30-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone


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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC

February 10, 2005


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